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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,953	07/11/2001	Achim H. Krotz	ISIS-4797	9234
34138	7590	06/24/2004	EXAMINER	
COZEN O'CONNOR, P.C. 1900 MARKET STREET PHILADELPHIA, PA 19103-3508			SCHULTZ, JAMES	
			ART UNIT	PAPER NUMBER
			1635	

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,953

Applicant(s)

KROTZ ET AL.

Examiner

J. Douglas Schultz, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Application/Amendment/Claims

Applicant's response filed April 5, 2004 has been considered. Rejections and/or objections not reiterated from the previous office action mailed December 4, 2003 are hereby withdrawn. The following rejections and/or objections are either newly applied or are reiterated and are the only rejections and/or objections presently applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments re: Claim Rejections - 35 USC § 102

Claims 1-5, 7-12, and 14 stand rejected under 35 U.S.C. 102(e) as being anticipated by Zhang et al., for the same reasons of record as cited in the Office action mailed November 20, 2002.

Applicants traverse this rejection by pointing out that the present rejection based on Zhang *et al.* is not properly a rejection under 35 U.S.C. § 102(b), because Zhang *et al.* published one day before the filing date of the instant invention. The Office agrees. The reference is properly a 35 U.S.C. § 102(e) reference. In fact, the rejection as formulated in the first action on the merits, mailed November 20, 2002, cited this rejection as one under 35 U.S.C. § 102(e). Furthermore, every Office action since then has referred to the rejection "of record as cited in the Office action mailed November 20, 2002". This is the only rejection under 35 U.S.C. § 102 ever made in the entire prosecution history of the instant application, so there should have been little confusion on applicants part that the rejection was made under 35 U.S.C. § 102(e). Thus,

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applicants' position that an "e", inadvertently substituted for a "b" in a subsequent Office action, necessarily warrants its removal as a reference under 35 U.S.C. § 102 is not considered convincing. It is maintained that applicants, through a brief review of the prosecution history, could have easily verified that the 35 U.S.C. § 102 rejection of November 20, 2002, which is referred to in each subsequent rejection, stood as a rejection under 35 U.S.C. § 102(e)

Furthermore, applicants have had an opportunity to argue the merits of the rejection under 35 U.S.C. § 102, which they have not done in the most recently submitted response. Therefore, while it is agreed that that the instant rejection was made over a reference that was properly a 35 U.S.C. § 102(e) (or potentially 35 U.S.C. § 102(a), although such rejection has not been made) and not a 35 U.S.C. § 102(b), the rejection is maintained because A) the rejection was properly made under 35 U.S.C. § 102(e) in the action mailed November 20, 2002 wherein the 35 U.S.C. § 102(e) statute was cited, B) there has only been one rejection of record under 35 U.S.C. § 102, and C) because every action since November 20, 2002 has referred specifically to the rejection of November 20, 2002.

Claim Rejections - 35 USC § 103

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as being obvious over Zhang et al. in view of Demopoulos et al. (U.S. Patent Number 6,204,248), for the same reasons of record as set forth in the Office action mailed November 20, 2002.

Applicants argue that the instant rejection under 35 U.S.C. § 103(a), which relies upon a reference (Zhang *et al.*) which is not a reference under 35 U.S.C. § 102(b), cannot be sustained. The following is a quotation of 35 U.S.C. 103(a) which formed the basis for the instant

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obviousness rejection as set forth in the Office action mailed November 20, 2002, upon which this rejection relies upon:

103(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

It is noted that the 35 U.S.C. § 103(a) statute requires only that the reference apply under 35 U.S.C. § 102, and does not indicate which paragraph the 35 U.S.C. § 102 applies under. Thus, a reference that applies under either of 35 U.S.C. § 102(b) or 35 U.S.C. § 102(e) may be relied upon as the basis for a rejection under 35 U.S.C. § 103(a). Because the instant rejection relies upon a reference which is a 35 U.S.C. § 102(e), the rejection is maintained.

In the event that applicant intends to rely upon 35 U.S.C. § 103(c) in order to provide exemption from the application of 35 U.S.C. § 103(a) against the instant claims, it is noted that such a reliance would be improper. For two reasons. First, because the Zhang reference also qualifies under 35 U.S.C. § 102(a), the reference does not meet the qualifications of 35 U.S.C. § 103(c) which requires that the invention be only applicable under one or more of 35 U.S.C. § 102(e), (f) or G):

(c) Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Second, the inventions were not owned by the same person or subject to an obligation of assignment to the same person at the time of filing. For these reasons, 35 U.S.C. § 103(c) is not considered to apply in this situation.

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Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Douglas Schultz, Ph.D. whose telephone number is 571-272-0763. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on 571-272-0760. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JD Schultz, PhD



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